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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,051	04/26/2001	Masahiko Miyamoto	03409.0066	6514

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/842,051

Applicant(s)

MIYAMOTO, MASAHIKO

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 6-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office action is responsive to communication received 04/26/2001 – Priority papers; 05/13/2002 – Amendment A.

Claims 2 and 5 have been cancelled, as directed.

Claims 1, 3, 4 and 6-11 remain pending.

Following a six-month suspension of action in this application, it is noted that the references to Kajita, Long and McCabe (copies included with this Office action) have been discovered subsequent to the mailing of the last Office action. Upon further review, these references have been deemed to be pertinent as prior art of interest only, without any reliance being made upon any of these three references in the rejection of the claims set forth below.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4 and 6-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Werner in view of Masghati. Werner shows the underlying theme of applicant's claimed invention and includes a wood-type club head having a face divided into upper and lower portions, with the roll radius of the upper portion being less than the roll radius of the lower portion. Reference is made to Figure 8 in Werner and the discussion in column 9, lines 31-51, wherein Werner details that the lower part of the

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face defines a flattened portion (34), while the upper portion is defined by a curvature (roll). As a matter of simply referencing the manner in which Werner is most closely related to applicant's claimed invention, note that impact point (32) in the Werner patent would appear to correlate to point "SS" shown in applicant's Figure 1. Werner differs from the claimed invention in that Werner does not show the precise, claimed radii for the face, specifically a roll radius of between 152 and 305 mm for the upper portion and a roll radius of between 310 mm and 406 mm for the lower portion. The secondary reference to Masghati highlights that a roll radius of at least 9 ½ inches (241.3 mm) and as much as 16 inches (406 mm) is known to have been contemplated in the prior art clubfaces, noting that an increase in the radius of curvature tends to flatten the roll somewhat, but results in a more nearly uniform loft angle from the top to the bottom of the club. See column 2, lines 44-49 along with column 4, line 55 through column 5, line 10 and Figures 10 and 12 in Masghati. In view of the patent to Masghati, it would have been obvious to modify the device in the cited art reference to Werner by incorporating a roll radius of between 152 and 305 mm for the upper portion and a roll radius of between 310 mm and 406 mm for the lower portion, the motivation being to desirably affect the trajectory of a struck ball. Further, the claimed, dimensional limitations are not deemed critical. Insofar as the claimed requirements that the club head include a hollow, metallic structure, note that Werner suggests, for example, that the club in Figure 7 is modeled after what is typically known as a "wood" and is more commonly made of metal (column 4, lines 56-57). Moreover, the teaching reference to Masghati obviates the use of hollow, metallic shell structure for the club head by noting

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that the use of “wood” and “wood-type” are not literally restricting, but may incorporate club heads shaped like traditional wooden club heads and alternatively made of metal, plastic and other materials (column 6, lines 53-57).

### RESPONSE TO ARGUMENTS

In the arguments received 05/13/2002, the applicant contends that the teaching reference to Masghati fails to disclose separate roll radii for the upper and lower portions of the striking face. The applicant contends that neither Masghati nor Werner disclose the claimed golf club head having the claimed combination of roll radii.

In response to these arguments, it is noted that the applicant appears to have attacked the references individually. Where the combination is based upon a combination of references as is the case here, it is improper to show non-obviousness by separately deciphering each reference. See In re Keller, 208 USPQ 871 (CCPA 1981). In this case, it is the primary reference to Werner that sets forth the basic invention, as claimed by the applicant. In other words, it is the Werner teaching that details that it is old in the art to provide a dual roll radii striking face. Masghati simply details the benefits of radii of specific values. The fact that Masghati reveals a constant roll radius from top-to-bottom for the striking face is immaterial. What the skilled artisan extols from the reference is the fact that a higher value for the roll radius tends to flatten out the roll and may produce a more uniform loft angle. In addition, Masghati appears to suggest that the value of the roll is commensurate with the degree of uniformity in loft. In other words, the value of the variable “roll” is recognized as being result-effective. Where a parameter optimized is recognized as being result-effective, that optimization

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is normally considered an obvious matter to one of ordinary skill in the art. See In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). As Werner already contemplates the use of both a flattened and less-than-flat roll radius, it is clear that combining the Werner and Masghati teachings would have been obvious to the skilled artisan, as both references are concerned with the effect of the roll radius on the trajectory of a struck ball. Moreover, under the circumstances here, it is deemed that the applicant's claimed dimensions involve no more than the optimization of a result-effective variable and would have been obvious to one having ordinary skill in the art, based on the teachings in Masghati.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
March 4, 2003